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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
LUONG, VINH	

ART UNIT	PAPER NUMBER
3656	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/540,713	HAUSSECKER ET AL.	
	Examiner	Art Unit	
	Vinh T. Luong	3656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 August 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-19,21 and 23* is/are pending in the application.

4a) Of the above claim(s) *2,6,11-13,15-17,19 and 21* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4,5,7-10,14,18 and 23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 October 2009* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☒ Other: *Appendixes 1-3*.

1. The final rejection on October 21, 2010 is withdrawn and replace by the following non-final rejection.

2. In view of the appeal brief filed on August 13, 2010, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Richard WL Ridley/

Supervisory Patent Examiner, Art Unit 3656

3. The amendment filed on August 13, 2010 has been entered.

4. Claims 2, 6, 11-13, 15-17, 19, and 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 10, 2009.

5. Applicant is advised that should claim 1 be found allowable, claim 9 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). See also claims 5 and 14, 7 and 18, *etc.*

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1, 4, 5, 7-10, 14, 18, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hager et al. (WO 01/61133 A1 cited in the specification) in view of Cadle et al. (US 6,422,755).

Claims 1 and 9

Hager teaches a drive unit for actuating drives in a motor vehicle with a first housing part 2 and a second housing part 15 connected to the first housing part 2 by means of connecting elements 4, wherein the first housing part 2 features receptacles 5 for the connecting elements 4, and the first and second housing parts 2 and 15 are assigned bearing functions for an armature shaft 14.

Hager teaches the invention substantially as claimed. See the translation attached to the Office action on February 22, 2010. However, Hager does not teach the receptacles embodied as centering holes for corresponding centering pins arranged on the second housing part and the second housing part featuring counter receptacles for the connecting elements surrounding at least partially by the centering pins.

As shown in FIGS. 30a and 30b, Cadle teaches the receptacles embodied as centering holes 634 and 636 (FIG. 30a) for corresponding centering pins 630 and 632 arranged on the second housing part 622, the second housing part 622 featuring counter receptacles/bolt holes (see Appendix 1 hereinafter "App. 1") for the connecting elements/bolts surrounding at least partially by the centering pins 630 and 632 and the first and second housing parts 620 and 622 in order to be assigned bearing functions to avoid the connecting elements/bolts bearing against the sides of the bolt holes (Cadle 10:5-27).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the receptacles embodied as centering holes for centering pins arranged on Hager's second housing part and Hager's second housing part featuring counter receptacles for Hager's connecting elements surrounding at least partially by the centering pins in order to be assigned bearing functions to avoid the connecting elements/bolts bearing against the sides of the bolt holes as taught or suggested by Cadle. The modification of Hager's drive unit by forming the receptacles embodied as centering holes for centering pins as taught or suggested by Cadle would not have been uniquely challenging to a person of ordinary skill in the art because it is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement" *KSR Int'l. Co. v. Teleflex Inc.,* 127 S. Ct. 1727, 1741 (2007) and it "does no more than yield predictable results." *KSR* at 1739.

Claim 4

Cadle's centering pins 630 and 632 are embodied to be sleeves (FIGS. 30a and 30b).

Claims 5 and 14

See lead-in bevels (at 630 or 632 in FIGS. 30a and 30b) formed on Cadle's centering pins 630 and 632. (Cadle 10:5-27)

Claims 7 and 18

Hager teaches the centering (bore) holes (not shown) arranged as through bore holes in a flange for the connecting element 4 passing through as seen in Hager's FIG. 1 (App. 2) and described in Applicant's Spec. ¶ 3. To choose the thickness of Hager's centering holes such that it is greater than the height of the centering pin would have been a matter of choice in design since the claimed structures and the function they perform are the same as the prior art. *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995) citing *In re Gal*, 980 F.2d 717, 719, 25 USPQ2d 1076, 1078 (Fed. Cir. 1992). See also *stare decisis* regarding changes in size or proportion in MPEP § 2144.04.

Claim 8

Cadle's centering pin 630 or 632 forms a clearance fit together with the centering holes 634 or 636. (Cadle 2: 9-15, 7:7-27).

Claim 10

Hager's centering bore holes include pocket or through holes. See Applicant's admission in Spec., ¶ 3 quoted below:

> "The pole pot is composed of a deep-drawn, smoothed-down, cylindrical tube on whose open end a flange is formed in which holes to accommodate screws are left open. Formed in the flange of the gear housing are *pocket threads into which the screws are screwed* thereby solidly connecting the two parts of the housing with one another." (Emphasis added).

Claim 23

See claim 1 above. In addition, Cadle teaches the centering pins 630, 632 and the second housing part 622 formed as one unitary piece in order to reduce the cost of manufacturing (Cadle 1:66-2:8). In addition, as noted, the determination of patentability is based on the product itself, not by its method of production, such as, injection molding. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985); *SmithKline Beecham Corp. v. Apotex Corp.*, 78 USPQ2d 1097 (Fed. Cir. 2006); and MPEP § 2113.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form Hager's centering pins and second housing part as one unitary piece by, *e.g.*, injection molding in order to reduce the cost of manufacturing as taught or suggested by Cadle. *KSR, supra.*

8. Claims 1, 4, 7, 9, 10, 18, and 23 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Nakahashi et al. (US 4,987,791) in view of Kurome et al. (US 4,156,821 cited by Applicant).

Claims 1 and 9

Nakahashi teaches a drive unit for actuating drives in a motor vehicle with a first housing part 1 and a second housing part 2 connected to the first housing part 1 by means of connecting elements (App. 3), wherein the first housing part 1 features receptacles (App. 3) for the connecting elements, characterized in that the receptacles (App. 3) are embodied as centering holes (App. 3) and the second housing part 2 features counter receptacles (App. 3) for the connecting elements (App. 3), and characterized in that the first and second housing parts 1 and 2 are assigned bearing functions for an armature shaft 4.

Nakahashi teaches the invention substantially as claimed. However, Nakahashi does not teach the corresponding centering pins arranged on the second housing part 2 and the counter receptacles surrounding at least partially by the centering pins.

Kurome teaches the corresponding centering pins Cy (FIG. 8) arranged on the second housing part L and the counter receptacles Rt (FIG. 9) surrounding at least partially by the centering pins Cy for precisely fitting the connecting elements Bo. (Kurome 9:13-54)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the corresponding centering pins arranged on Nakashima's second housing part and Nakashima's counter receptacles surrounding at least partially by the centering pins in order to precisely fit Nakashima's connecting elements as taught/suggested by Kurome. *KSR, supra.*

Claim 4

Kurome's centering pins Cy are embodied to be sleeves (FIG. 8).

Claims 7 and 18

Nakahashi teaches the centering holes (App. 3) arranged as through bore holes in a flange (at 5 in FIG. 2A, see App. 3) for the connecting element (App. 3) passing through. To choose the thickness of Nakahashi's centering holes such that it is greater than the height of the centering pin would have been a matter of choice in design since the claimed structures and the function they perform are the same as the prior art. *In re Chu* and MPEP § 2144.04, *supra.*

Claim 10

Nakahashi's counter receptacles are embodied as pocket or through holes (App. 3).

Claim 23

See claim 1 above and please note that Kurome's centering pins Cy are formed as one unitary piece with the second housing part L (FIGS. 8 and 9). In addition, the determination of patentability is based on the product itself, not by its method of production, such as, injection molding. *In re Thorpe*; *SmithKline Beecham Corp. v. Apotex Corp.*; and MPEP § 2113 *supra*.

9. Claims 5, 8, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakahashi and Kurome as applied to claim 1 above, and further in view of Cadle et al.

Claims 5 and 14

Nakahashi and Kurome teach the invention substantially as claimed. However, Nakahashi and Kurome do not teach the lead-in bevels formed on the centering pins.

Cadle teaches the lead-in bevels (at 630 or 632 in FIGS. 30a and 30b) formed on Cadle's centering pins 630 and 632 in order to avoid the connecting elements (bolts) bearing against the sides of the receptacles (bolt holes) which can introduce distortion and stress that can lead to engine failure. (Cadle 10:5-27)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the lead-in bevels on Kurome's centering pins in Nakashima's drive unit in order to avoid the connecting elements bearing against the sides of the receptacles which can introduce distortion and stress that can lead to engine failure as taught or suggested by Cadle. *KSR, supra*.

Claim 8

Nakahashi and Kurome teach the invention substantially as claimed. However, Nakahashi and Kurome do not teach the centering pin forming a clearance fit together with the centering holes.

Cadle teaches the centering pin 630 or 632 forming a clearance fit together with the centering holes 634 or 636 in order to control the axial positioning of the connecting elements (bolts). (Cadle 2: 9-15, 7:7-27).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make Kurome's centering pin forming the clearance fit together with the centering holes in Nakahashi's drive unit order to control the axial positioning of the connecting elements as taught or suggested by Cadle. *KSR, supra.*

10. Applicant's arguments filed on October 27, 2009; May 18, 2010; and August 13, 2010 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 1, 4, 5, 7-10, 14, 18, and 23 have been considered but are moot in view of the new ground(s) of rejection.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vinh T Luong/
Primary Examiner, Art Unit 3656